

### **Rejection of Claims 1-75 Under 35 U.S.C §103(a)**

The Examiner states that claims 1-75 are unpatentable over *Miller* under 35 U.S.C §103(a). According to the Examiner, *Miller* discloses “a method of conducting an online auction between a plurality of potential bidders, the plurality of potential bidders competing for a lot having at least one product, comprising receiving a first bid and a second bid.” The Examiner also states that *Miller* discloses an English auction, a system for conducting an online auction, and a computer program.

The Examiner further asserts that *Miller* does not disclose storing information reflective of a submitted first bid nor enabling a second bidder to view a bid originally defined in a context of a first bidder in a context of the second bidder.

According to the Examiner, the advantage of the English auction is that it “permits several bidders to collectively determine the fair value of a bidded upon item” and it would, therefore, have been obvious to inform the second bidder of the first bidder’s bid in the method of *Miller*.

Based upon the claim amendments presented above and the reasoning presented below, Applicants respectfully submit that claims 1-75 are patentable over *Miller*.

### **Claim 1**

According to the M.P.E.P. §706.02(j), in order to establish a *prima facie* case for obviousness under 35 U.S.C. §103(a) the reference(s) cited by the Examiner must, “teach or suggest all the claim limitations.”

Amended claim 1 recites, *inter alia*, “receiving first bid information. . . that is originally defined in a context of said first bidder” and “transmitting second bid information defined in a context of a second bidder that is different than said context of said first bidder to said second bidder, said transmitted second bid information enabling said second bidder to view a bid originally defined in a context of said first bidder in said context of said second bidder.” *Miller* teaches receiving bid slates from bidders at column 6, lines 1-3. At column 6, lines 42-61, *Miller* then evaluates combinations of bids to determine whether the total resource allocation for each combination exceeds a maximum allowed allocation. If the maximum allowed allocation is not exceeded, the total bid price for the bid combination is computed and compared with the highest bid combination evaluated so far. If the current price exceeds the previous high bid price, the current bid price is stored as the highest bid combination.

*Miller* does not teach or suggest at least “transmitting second bid information defined in a context of a second bidder that is different than said context of said first bidder. . .” as recited in claim 1. Significantly, *Miller* does not teach or suggest transmitting any data to a bidder that enables that bidder to see information received from any other bidder. *Miller* also does not teach receiving bid information in a context of a first bidder and transmitting that bid information in a different context. The Examiner even states that *Miller* does not disclose “enabling the second bidder to view a bid originally defined in a context of the first bidder in a context of the second bidder,” and does not offer any reference or ground to support an obviousness rejection for that element. Moreover, the amendment to claim 1 included herein clarifies that those first and second contexts are different. Thus, Applicants submit that the *Miller* reference does not teach or suggest transmitting second bid information defined in a context of a second bidder that is different than said context of said first bidder.

Furthermore, according to M.P.E.P. §706.02(j) in order to establish a *prima facie* case for obviousness under 35 U.S.C. §103(a) when the Examiner combines reference teachings “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” Moreover, as discussed in M.P.E.P. §2143.01, the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. 2143.01, Sixth Paragraph, citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis original).

The Examiner further asserts that it would be obvious to inform a second bidder of a first bidder’s bid in *Miller* in light of *Miller*’s disclosure of an English auction. Applicant maintains that although *Miller* recites an “English auction” as one of several types of prior art auctions in the Background of the Invention section at Col. 2., lines 13-17, there is no motivation, as suggested by the Examiner, to use the open-bid English auction methodology in the arbitration system of *Miller*. Significantly, *Miller* teaches away from combining an English auction with the method claimed in *Miller*. The stated objects of *Miller* are to provide a diverse goods arbitration system...” and to “provide an efficient and fair system and method for allocating a plurality of computer resources...” (Col. 2, lines 45-55). According to *Miller*, however, the disclosed prior art auctions, including English auctions, are “well proven systems for allocating a single resource,” but they are “not appropriate for the simultaneous arbitration of multiple goods...” Col. 2, lines 26-33. Additionally, according to *Miller*, English auctions are “also known as first-price, open-bid auctions.” Col. 2, lines

14-15. Yet, *Miller* specifically teaches that the arbitration system of *Miller* uses a “variant of the second-price sealed-bid auction.” Col. 2, lines 60-62. Accordingly, it would be illogical to combine the prior art English auction system with the arbitration system of *Miller*. Further, there can be no expectation that such a combination would be successful based on the disclosure in *Miller*, because *Miller* specifically teaches that English auctions are not appropriate for the simultaneous arbitration of multiple goods. Thus, Applicants submit that combination of the *Miller* methodology and an English auction is improper because there can be no expectation that such a combination would be successful based on the disclosure in *Miller*, and *Miller* actually teaches away from such a combination.

Furthermore, because the “goal of the arbitration mechanism [in *Miller*] is not to maximize monetary return to the arbiter, but rather to allocate resources to maximum declared value,” *Miller* does not encourage modification of amounts bid in bid slates. Col. 2, lines 64-66. Because *Miller* does not encourage competitive bidding of bidders by placing the bidders in direct competition with one another to maximize monetary return, but rather selects the combination of bids that maximizes resource allocation, there is no motivation in *Miller* to use an English auction to provide “bid information of one bidder to other bidders,” as suggested by the Examiner, because such sharing would have no impact on a given arbitration. As discussed above, the mere fact that references can be combined is not sufficient to render the combination obvious. Thus, Applicants submit that there is no motivation in *Miller* to provide bid information of one bidder to other bidders.

For the forgoing reasons, Applicants maintain that claim 1 is patentable over *Miller*, and respectfully request that the Examiner pass claim 1 to allowance.

#### **Claims 2-20**

Claims 2-20 depend from claim 1, which the Applicants assert is patentable over *Miller*. For the reasons cited above for claim 1, Applicants maintain that claims 2-20 are also patentable over *Miller*, and respectfully request that the Examiner pass claims 2-20 to allowance.

#### **Claims 21-40**

The assertions presented in connection with claim 1 are equally applicable to the system of claim 21. Thus, Applicants submit that claim 21 is patentable over *Miller*, and respectfully request that the Examiner pass claim 21 to allowance.

Claims 22-40 depend from claim 21, which Applicants submit is allowable. As such, Applicants submit that claims 22-40 are also allowable.

### **Claims 41-60**

Independent claim 41, as originally submitted, recites “transmitting first bid information. . . representing a first bid that is originally defined in a context of a first bidder, said transmitted first bid information being used by the auction server in a comparison of submitted bids originally defined in contexts different from said first bidder.”. Thus, at least the assertion regarding *Miller* not teaching or suggesting transmitting second bid information defined in a context of a second bidder that is different than said context of said first bidder, which was presented in connection with claim 1, is equally applicable to claim 41.

Applicants, therefore, submit that claim 41 and claims 42-60 which depend therefrom, are also patentable over *Miller*. Applicants, furthermore, request that the Examiner pass claims 41-60 to allowance.

### **Claims 61-64**

Claim 61 recites, *inter alia*, comparing transformed bids defined in at least two different bidder specific contexts to be compared on a common basis. Thus, at least the assertion regarding *Miller* not teaching or suggesting operating on second bid information defined in a context of a second bidder that is different than said context of said first bidder, which was presented in connection with claim 1, is equally applicable to claim 61.

Applicants, therefore, submit that claim 61 and claims 62-64 which depend therefrom, are also patentable over *Miller*. Applicants, furthermore, request that the Examiner pass claims 61-64 to allowance.

### **Claims 65-68**

Claim 65 also recites, *inter alia*, comparing bids defined in at least two different bidder specific contexts on a common basis. Thus again, at least the assertion regarding *Miller* not teaching or suggesting operating on bid information defined in at least two different contexts, which was presented in connection with claim 1, is applicable to claim 65. Claim 66 has been cancelled herein and claims 67 and 68 depend from claim 65. Applicants, therefore, submit that claim 65, and claims 67 and 68 which depend therefrom, are patentable over *Miller*. Applicants, furthermore, request that the Examiner pass claims 65, 67, and 68 to allowance.

### **Claims 69-71**

Claim 69 also recites, *inter alia*, comparing bids defined in at least two different bidder specific contexts on a common basis. Thus again, at least the assertion regarding *Miller* not teaching or suggesting operating on bid information defined in at least two

contexts, which was presented in connection with claim 1, is applicable to claim 69. Claim 70 has been cancelled herein and claim 71 depends from claim 69. Applicants, therefore, submit that claim 69, and claim 71 which depends therefrom, are patentable over *Miller*. Applicants, furthermore, request that the Examiner pass claims 69 and 71 to allowance.

#### **Claim 72**

Claim 72 recites, *inter alia*, displaying a comparison of bids originally defined in contexts different from a first bidder in a context of the first bidder. Thus, at least the assertion regarding *Miller* not teaching or suggesting operating on bid information defined in at least two contexts, which was presented in connection with claim 1, is applicable to claim 72. Applicants, therefore, submit that claim 72, is patentable over *Miller* and request that the Examiner pass claim 72 to allowance.

#### **Claim 73**

Claim 73 recites, *inter alia*, enabling an auction server to generate a relative comparison of bids, originally defined in at least two different bidder-specific contexts, on a common competitive basis. Thus, at least the assertion regarding *Miller* not teaching or suggesting operating on bid information defined in at least two contexts, which was presented in connection with claim 1, is applicable to claim 73. Applicants, therefore, submit that claim 73, is patentable over *Miller* and request that the Examiner pass claim 73 to allowance.

#### **Claim 74**

Claim 74 recites, *inter alia*, a computer program product enabling a second bidder to view a bid originally defined in a context of a first bidder in a context of the second bidder, wherein the context of the second bidder is different than the context of the first bidder. Thus, at least the assertion regarding *Miller* not teaching or suggesting operating on bid information defined in at least two contexts, which was presented in connection with claim 1, is applicable to claim 74. Applicants, therefore, submit that claim 74, is patentable over *Miller* and request that the Examiner pass claim 74 to allowance.

#### **Claim 75**

Claim 75 recites, *inter alia*, a computer program product enabling submitted bids, defined in at least two different bidder-specific contexts, to be compared on a common competitive basis. Thus, at least the assertion regarding *Miller* not teaching or suggesting operating on bid information defined in at least two contexts, which was presented in

connection with claim 1, is also applicable to claim 75. Applicants, therefore, submit that claim 75, is patentable over *Miller* and request that the Examiner pass claim 75 to allowance.

**Rejection of Claims 1-75 for Double Patenting under 37 C.F.R. 1.78(b)**

In the Office Action, the Examiner stated that claims 1-75 conflict with claims 1-75 of Application 08/282,156. Applicants assume that the Examiner actually intended to suggest that those claims conflict with claims 1-32 of application 09/282,156 (the "'156 Application"), which is assigned to the same entity as the Subject Application. According to MPEP § 804(II)(A), "identical subject matter" must be claimed in both applications for a statutory double patenting rejection to be appropriate. Furthermore, a reliable test "for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the [other application]. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970)" (the "Test").

The Examiner did not include a statement in the Office Action as to why he believed that the subject matter claimed in the Subject Application is identical to the claims of the '156 Application. The Examiner also did not apply the test suggested by the Manual of Patent Examining Procedure to those claims. Thus, the basis for the double patenting rejection is unclear.

Applying the Test to the claims of the subject Application and the '156 Application, Claims 1, 7, 12, 22, and 32 of the '156 Application recite generating a net present value bid value representing a sum of a series of payments over a plurality of contract term segments which are discounted to the present value. Claim 1 of the Subject Application recites (a) receiving first bid information for a lot from a first bidder, said received first bid information representing a first bid that is originally defined in a context of said first bidder; (b) storing information reflective of said submitted first bid, said stored information enabling a relative comparison of submitted bids on a common competitive basis; and (c) transmitting second bid information defined in a context of a second bidder that is different than said context of said first bidder to said second bidder, said transmitted second bid information enabling said second bidder to view a bid originally defined in a context of said first bidder in said context of said second bidder.

Applying the Test to those claims, in one embodiment of the Subject Application covered by claim 1, a purchasing decision is based on multiple non-comparative parameters. That embodiment is illustrated in Figures 5 and 6 described in the specification at least from line 7 of page 9 through line 22 of page 17. In that embodiment, the purchaser wishes to


maximize the number of BTUs that it will be able to extract from coal per dollar spent purchasing coal. Two bidders will place bids to sell coal in units of dollars per ton. The coal of the two suppliers, however, has different thermal content, expressed in BTU/lb. Thus, the price bid by the suppliers will not express the cost per BTU as the purchaser desires. The purchaser, therefore, obtains from the bidders an average BTU/lb for the coal each bidder intends to supply. With knowledge of the BTU/lb of the coal and the \$/ton bid, as well as the standard factor used to convert tons to pounds, the purchaser will determine the cost in dollars per BTU of coal bid by each bidder. The purchaser may furthermore convert \$/ton bid by the First Bidder (the context of the First Bidder) to an equivalent \$/ton for coal having the thermal content of the coal to be supplied by the Second Bidder (the context of the Second Bidder). The purchaser may then transmit the bid information received from the First Bidder in the context of the First Bidder to the Second Bidder in the context of the Second Bidder. In that scenario, claim 1 of the Subject Application is literally infringed. In that scenario, however, a net present value bid value representing a sum of a series of payments over a plurality of contract term segments which are discounted to a present value is not generated. Thus, that scenario would not infringe any of the claims of the '156 Application. Thus, because a claim of the Subject Application could be literally infringed without literally infringing any claim of the '156 Application, Applicants submit that the double patenting rejecting is inappropriate for claim 1. Furthermore, Applicants submit that a parallel situation exists for every other claim of the Subject Application. Thus, Applicants submit that the double patenting rejection is inappropriate for all claims of the Subject Application and request reconsideration of that rejection and passage to allowance of those claims.

### **CONCLUSION**

In view of the foregoing, it is respectfully submitted that all independent claims of the Subject Application are in condition for allowance, and that each dependent claim depending therefore is also allowable. Applicant furthermore submits that no new matter has been introduced into the amendments presented herein. Accordingly, reconsideration of the rejections presented in the Office Action dated May 30, 2001 and passage to allowance of all pending claims at an early date are earnestly solicited. If the Examiner is of the opinion that the instant application is in condition for disposition other than allowance, the Examiner is

invited to contact the undersigned at 412-560-7062 in order that any concerns may be expeditiously addressed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard W. James", is written over a horizontal line.

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**Marked-up Version under 37 C.F.R. § 1.121 (C)(1)**

1. (Amended) A method of conducting an electronic online auction between a plurality of potential bidders, the plurality of potential bidders competing for a lot having at least one product, comprising the steps of:

- (a) receiving first bid information for a lot from a first bidder, said received first bid information representing a first bid that is originally defined in a context of said first bidder;
- (b) storing information reflective of said submitted first bid, said stored information enabling a relative comparison of submitted bids on a common competitive basis; and
- (c) transmitting second bid information [to a second bidder, said transmitted second bid information enabling said second bidder to view a bid originally] defined in a context of [said first bidder in a ]a second bidder that is different than said context of said first bidder to said second bidder, said transmitted second bid information enabling said second bidder to view a bid originally defined in a context of said first bidder in said context of said second bidder.

21. (Amended) A system for conducting an electronic online auction between a plurality of potential bidders, the plurality of potential bidders competing for a lot having at least one product, comprising:

means for receiving first bid information for a lot from a first bidder, said received first bid information representing a first bid that is originally defined in a context of said first bidder;

means for storing information reflective of said submitted first bid, said stored information enabling a relative comparison of submitted bids on a common competitive basis; and

means for transmitting second bid information [to a second bidder, said transmitted second bid information enabling said second bidder to view a bid originally] defined in a context of [said first bidder in a ]a second bidder that is different than said context of said first bidder to said second bidder, said transmitted second bid information enabling said second bidder to view a bid originally defined in a context of said first bidder in said context of said second bidder.

61. (Amended) A method of conducting an electronic online auction between a plurality of potential bidders, the plurality of potential bidders competing for a lot having at least one product, comprising the steps of:

- (a) receiving bid information from a first bidder for said lot; and
- (b) generating a transformed bid using at least said bid information, said generated transformed bid being used to effect a relative comparison of transformed bids, said relative comparison of transformed bids enabling submitted bids, defined in [one or more] at least two different bidder-specific contexts, to be compared on a common competitive basis.

65. (Amended) A system for conducting an electronic online auction between a plurality of potential bidders, the plurality of potential bidders competing for a lot having at least one product, comprising:

- means for receiving bid information from a first bidder for said lot; and
- means for generating a transformed bid using at least said bid information, said generated transformed bid being used to effect a relative comparison of transformed bids, said relative comparison of transformed bids enabling submitted bids, defined in [one or more] at least two different bidder-specific contexts, to be compared on a common competitive basis.

69. (Amended) A method of participating in an electronic online auction [between a plurality of ]including a plurality of participants, wherein the participants include a sponsor and at least two potential bidders, the [plurality of] potential bidders competing for [a lot having at least one product] award of a lot, comprising [the steps of]:

- (a) receiving bid information defined in a first context from a first bidder for said lot;
- (b) [generating a transformed bid using at least] redefining said bid information to a second context that differs from said first context; and
- (c) [transmitting transformed bid information to an auction server,] comparing said transformed bid information [enabling said auction server to generate a relative comparison of bids, originally defined in one or more bidder-specific contexts,] to other bid information on a common competitive basis.

72. (Amended) A computer program product for enabling a processor in a computer system to process bidding information in an auction between a plurality of bidders, said computer program product comprising:

a computer usable medium having a computer readable program code [means] embodied in said medium for causing an application program to execute on the computer system, said computer readable program code [means] comprising

a first computer readable program code [means for] enabling the computer system to transmit first bid information for a lot having at least one product to an auction server, said transmitted first bid information representing a first bid that is originally defined in a context of a first bidder, said transmitted first bid information being used by the auction server in a comparison of submitted bids originally defined in contexts different from said first bidder;

a second computer readable program code [means for] enabling the computer system to receive second bid information from said auction server, said received second bid information representing a second bid that was submitted by a second bidder, said second bid being originally defined in a context different from said first bidder; and

a third computer readable program code [means for] enabling the computer system to display a relative comparison of said first bid and said second bid in a context of said first bidder [using said received second bid information].

73. (Amended) A computer program product for enabling a processor in a computer system to process bidding information in an auction between a plurality of bidders, said computer program product comprising:

a computer usable medium having a computer readable program code [means] embodied in said medium for causing an application program to execute on the computer system, said computer readable program code [means] comprising

a first computer readable program code [means for] enabling the computer system to receive bid information from a bidder for a lot [having at least one product];

a second computer readable program code [means for] enabling the computer system to generate a transformed bid using at least said bid information; and

a third computer readable program code [means for] enabling the computer system to transmit transformed bid information to an auction server, said transformed bid information enabling said auction server to generate a relative comparison of bids, originally defined in [one or more] at least two different bidder-specific contexts, on a common competitive basis.

74. (Amended) A computer program product for enabling a processor in a computer system to process bidding information in an auction between a plurality of bidders, said computer program product comprising:

a computer usable medium having a computer readable program code [means] embodied in said medium for causing an application program to execute on the computer system, said computer readable program code [means] comprising

a first computer readable program code [means for] enabling the computer system to receive first bid information for a lot having at least one product from a first bidder, said received first bid information representing a first bid that is originally defined in a context of said first bidder;

a second computer readable program code [means for] enabling the computer system to store information reflective of said submitted first bid, said stored information enabling a relative comparison of submitted bids on a common competitive basis; and

a third computer readable program code [means] for enabling the computer system to transmit second bid information defined in a context of a second bidder that is different than said context of said first bidder to [a] said second bidder, said transmitted second bid information enabling said second bidder to view a bid originally defined in [a] said context of said first bidder in [a] said context of said second bidder.

75. (Amended) A computer program product for enabling a processor in a computer system to process bidding information in an auction between a plurality of bidders, said computer program product comprising:

a computer usable medium having a computer readable program code [means] embodied in said medium for causing an application program to execute on the computer system, said computer readable program code [means] comprising

a first computer readable program code [means for] enabling the computer system to receive bid information from a first bidder for a lot having at least one product; and

a [first] second computer readable program code [means for] enabling the computer system to generate a transformed bid using at least said bid information, said generated transformed bid being used to effect a relative comparison of transformed bids, said relative comparison of transformed bids enabling submitted bids, defined in [one or more] at least two different bidder-specific contexts, to be compared on a common competitive basis.